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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,867	12/21/2001	Chan U. Ko	AVERP2997USA	4665
7590 03/04/2004			EXAMINER	
William C. Tritt Renner, Otto, Boisselle & Sklar, LLP Nineteenth Floor 1621 Euclid Avenue Cleveland, OH 44115-2191			CHANG, VICTOR S	
			ART UNIT	PAPER NUMBER
			1771	
DATE MAILED: 03/04/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/028,867

Applicant(s)

KO ET AL.

Examiner

Victor S Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 26, 27, 30-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25, 28 and 29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The Examiner has carefully considered Applicant's remarks filed on 2/5/2004.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn.

### ***Election/Restrictions***

4. Claims 26, 27 and 30-36, filed 9/23/2003, are directed to an invention that is independent or distinct from the invention originally claimed for the reasons set forth in section 4 of Paper No. 112503, together with the following additional observations.

Upon reconsideration, the Examiner notes that Applicant's argument that "... to further limit the plasticizer (B) ... claims 25, 28 and 29 require that the plasticizer (B) is liquid ..." (Remarks, page 7, bottom paragraph) is persuasive. Therefore, the restriction of claims 25, 28 and 29 has been withdrawn.

However, with respect to Applicants' argument that "new claims 25-36 are a subset of the original claims." (Remarks, page 7, bottom paragraph), the Examiner repeats (see Paper No. 112503, page 2) that each of claims 26, 27 and 30-36 recites plasticizers which is devoid of nitrile rubber, and also is not a subset of claims 1-24. In particular, in response to Applicants' contention that "claims 27 and 31 require that the plasticizer (B) is a terpolymer of (a) an olefin, (b) a comonomer selected from acrylic acids or esters, methacrylic acids, and vinyl acetates, and (c) carbon monoxide."

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(Remarks, page 7, bottom paragraph), the Examiner notes that the original presentation of a Markush group of claim 5 recites "ethylene-propylene terpolymer", i.e., a terpolymer of ethylene and propylene, which clearly does not encompass the terpolymer of claims 27 and 31, because "ethylene-propylene terpolymer" can only encompass one additional third co-monomer which is not olefin-based monomer, whereas the terpolymer of claims 27 and 31 requires at least two co-monomers which are not olefin-based monomer. As such, the Examiner repeats (see Paper No. 112503, page 2) that since Applicants have received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 26, 27 and 30-36 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Finally, the Examiner notes that while a telephone request to Heidi Boehlefeld was made on 2/19/2004 for a restriction requirement, no response has been received. Nevertheless, in view of the reasoning set forth above, the requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 112***

5. Claims 1-9 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to the term "a major amount", Applicants argument that "the term means that the material is present in an amount greater than 50% ... over a thousand U.S. patents have issued with the term "a major amount" ... a person of ordinary skill in the art upon reading the disclosure would be able to determine what is meant by the term "a major amount"" (Remarks, page 8, second full paragraph), the Examiner repeats (Remarks, page 8, second full paragraph) that Applicants fail to provide any evidentiary support to show that "a major amount" means an amount greater than 50%. In particular, it is noted that in claim 1 the instantly claimed vinyl halide film comprises three component elements (A), (B) and (C), and it is not clear to the Examiner whether "a major amount" of (A) encompasses 34% by weight, while (B) and (C) each is 33% by weight? Further, the Examiner notes that although the claims are interpreted in light of the Specification, limitations from the Specification are not read into the claims. See *In re Van Geuns*, 988 f.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). As such, the Examiner repeats (see Paper No. 5, page 2) that in claim 1, line 3, the phrase "a major amount" is vague and indefinite, i.e., it is not clear as to the scope of the limitation.

### ***Response to Amendment***

6. Claims 1-14, 25, 28 and 29 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kushida et al. (US 5344864), substantially for the reasons set forth in section 6 of Paper No. 112503, together with the following additional observations.

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With respect to Applicants' repeated argument that "Kushida et al. do not teach or suggest preparing a vinyl halide film from their polyvinyl chloride elastomeric compositions" (Remarks, page 9, second paragraph), the Examiner repeats (see Paper No. 112503, pages 3-4) that Kushida expressly teaches that when a plasticizer is incorporated, the vinyl chloride resin is used in many applications as resin material for various molded products such as films, sheets, etc. (column 1, lines 25-31), Applicants' argument to the contrary notwithstanding. Additionally, Applicants admitted that "Kushida states that its composition is directed to various applications for which conventional rubber is employed, such as packings, gaskets, sheets ..." (Remarks, page 9, bottom paragraph). As such, it would have been obvious to one of ordinary skill in the art to prepare a film from Kushida's composition, as films and "packings ... sheets" are clearly analogous art of the same field.

With respect to Applicants' argument that "Kushida does not disclose a PVC thermoplastic elastomer composition which exhibits an elongation of at least 50%" (Remarks, page 10, first full paragraph), the Examiner notes that although Kushida is silent about the elongation of the conventional rubbery packings and sheets, Kushida does teach that "the composition in which a non-crosslinked NBR is employed, provides a large elongation" (column 4, lines 9-11). As such, it is believed that a suitable elongation of rubbery packing material (e.g., packaging film) and sheets are either inherently disclosed, or an obvious optimization to one of ordinary skill in the art of rubbery films and sheets, motivated by the desire to obtain sufficient rubbery property.

With respect to Applicants' argument that "Kushida ... does not disclose a thickness for the film" (Remarks, page 10, second full paragraph), the Examiner repeats (see Paper No. 112503, page 4) that, in the absence of unexpected results, forming a film with a suitable thickness in the range of about 1-20 mils is believed to be well within the ordinary skill in the art of polymer films and sheets.

For newly added claims 25, 28 and 29, each of which recites in part "wherein (B) is liquid", the Examiner notes that Kushida teaches that "NBR useful in the present invention ... may be of a non-crosslinked type or crosslinked type" (column 4, lines 3-5). Since a non-crosslinked NBR is clearly a rubbery (viscoelastomeric) material, i.e., a viscous elastomeric flowable material or fluid, it is inherently a liquid.

7. Claims 22-24 are rejected under 35 U.S.C. 102(a) as being anticipated by Breton et al. (US 6054524), substantially for the reasons set forth in section 7 of Paper No. 112503, together with the following additional observations.

With respect to Applicants' argument that "There are no teachings in Breton that would lead one of ordinary skill in the art to modify Breton to use an aromatic solvent in place of the aliphatic solvent" (Remarks, page 11, first full paragraph), the Examiner repeats (see Paper No. 112503, page 4) that Breton expressly teaches that for economic reasons, primary aromatic plasticizers (i.e., aromatic solvents) are normally preferred (column 2, lines 6-7), Applicants' argument to the contrary notwithstanding.

With respect to Applicants' argument that "It appears that the Examiner is confusing the meaning of words "plasticizer" and "solvent" ... Breton does not disclose the use of an aromatic solvent" (Remarks, page 11, bottom paragraph), the Examiner

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notes that Applicants' provided definition of solvent as "solvent refers to capability of dissolving another substance or a substance in which another substance is dissolved, forming a solution" (Remarks, page 11, bottom paragraph) is clearly consistent with the fact that plasticizer is inherently a solvent to the substance being plasticized. Further, note also as evidence by J.K. Sears (Concise Encyclopedia of Polymer Science and Engineering, page 735, second column, first full paragraph), which teaches that "It is assumed that solvents or plasticizers of different classes are attracted to the resin macromolecule ... This results in a dynamic equilibrium between solvation and desolvation ...". As such, in the absence of a clear recitation of what constitutes "aromatic solvent", the Examiner asserts that while solvent may not be a plasticizer, a compatible plasticizer is inherently a solvent to the resin being plasticized, Applicants' argument to the contrary notwithstanding.

8. Claims 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kushida et al. (US 5344864), substantially for the reasons set forth in section 5 of Paper No. 5, together with the following additional observations.

For claims 15-21, the Examiner repeats that although Kushida lacks an express teaching of forming an adhesive article based on a plasticized PVC film, forming an adhesive tape based on a plasticized PVC film substrate is believed to be conventional and well known, as evidenced by the state of the art Bond et al. (US 3129816), which is directed to a highly conformable stretchable pressure sensitive adhesive tape with a plasticized PVC backing (column 1, lines 11-20). As such, it would have been obvious to one of ordinary skill in the art of conformable adhesive tape to use Kushida's

plasticized PVC film as a backing to form an adhesive film, motivated by the desire to obtain a highly conformable stretchable adhesive tape.

**9. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**10.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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*Daniel Zinker*